

**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION**

US SYNTHETIC CORPORATION,

Plaintiff,

VS.

ILJIN DIAMOND CO., LTD.; ILJIN HOLDINGS CO., LTD.; ILJIN USA INC.; ILJIN EUROPE GMBH; ILJIN JAPAN CO., LTD.; ILJIN CHINA CO., LTD.,

Defendants.

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CASE NO. 4:20-CV-03968-AHB

**DEFENDANT ILJIN USA INC.'S UNOPPOSED MOTION TO STAY
PENDING RELATED ITC PROCEEDINGS**

Pursuant to 28 U.S.C. § 1659, Defendant Iljin USA Inc., by its undersigned counsel, respectfully moves for a stay of the above-captioned case as to all defendants¹, pending the final determination in related proceedings before the United States International Trade Commission (ITC) involving Plaintiff US Synthetic Corporation.

On November 20, 2020, US Synthetic filed a complaint in the ITC alleging violations of 19 U.S.C. § 1337. Ex. A (“ITC Complaint”). The ITC Complaint alleges that Iljin USA, the Foreign Defendants, and other unrelated entities infringe one or more of U.S. Patent Nos. 9,932,274 (“the ’274 Patent”), 10,508,502 (“the ’502 Patent”), 9,315,881 (“the ’881 Patent”), 10,507,565 (“the ’565 Patent”), and 8,616,306 (“the ’306 Patent”). *Id.* at ¶ 5. The ITC proceeding

¹ Defendants Iljin Diamond Co., Ltd., Iljin Holdings Co., Ltd.; Iljin Europe GmH, Iljin Japan Co., Ltd., Iljin China Co., Ltd. (“Foreign Defendants”) are not parties to this Motion because they are foreign entities who have not been served with process as of the date of this Motion.

involves two patents that are the same two patents asserted in this case—the ’502 and ’565 Patents. *Compare* Dkt. No. 1, ¶ 1 *with* Ex. A at ¶ 5. The Notice of Institution of the ITC proceeding issued on December 21, 2020, but has not yet published in the Federal Register. Ex. B (“Notice of Institution”).

Section 1659(a) provides, in part:

Stay.—In a civil action involving parties that are also parties to a proceeding before the United States International Trade Commission under section 337 of the Tariff Act of 1930, at the request of a party to the civil action that is also a respondent in the proceeding before the Commission, the district court *shall stay*, until the determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding before the Commission, but only if such request is made within—

- (1) 30 days after the party is named as a respondent in the proceeding before the Commission, or
- (2) 30 days after the district court action is filed, whichever is later.

28 U.S.C. § 1659(a) (2018) (emphasis added).

Iljin USA states that the defendants, collectively, are entitled to a stay because they satisfy these conditions under § 1659(a). First, both the ITC and this action involve overlapping parties. *See generally* Ex. A. Second, Iljin USA’s motion is timely. This Motion is filed within 30 days of the institution announcement dated December 21, 2020. *See* Ex. B.

In requesting a stay, Iljin USA expressly reserves all of its objections and defenses to Plaintiff’s Complaint in this action, including without limitation, any waivable defense available under Rule 12 of the Federal Rules of Civil Procedure.

Counsel for Iljin USA conferred with counsel for Plaintiff regarding this Motion, and Plaintiff does not oppose.

For these reasons, Iljin USA respectfully requests that this Motion be granted pursuant to 20 U.S.C. § 1659(a) and that this Court stay this civil action as to all defendants.

Dated: December 23, 2020

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

/s/ Elizabeth M. Chiaviello

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**Pro hac to be filed*

**COUNSEL FOR DEFENDANT ILJIN USA
INC.**

CERTIFICATE OF SERVICE

I hereby certify that on December 23, 2020 a true and correct copy of the foregoing document was served on all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF filing system.

/s/ Elizabeth M. Chiaviello
Elizabeth M. Chiaviello

CERTIFICATE OF CONFERENCE

I hereby certify that on December 23, 2020 counsel for Defendant Iljin USA Inc. conferred with Plaintiff's counsel on this Motion, and Plaintiff's counsel does not oppose a stay of the above-captioned case pending the final determination in related proceedings before the ITC.

/s/ Elizabeth M. Chiaviello
Elizabeth M. Chiaviello